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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,462	03/09/2005	Toshiharu Otsuka	Q85518	2244

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EXAMINER
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BALDWIN, GORDON

ART UNIT	PAPER NUMBER
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1775

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,462	<b>Applicant(s)</b> OTSUKA ET AL.	
	<b>Examiner</b> Gordon R. Baldwin	<b>Art Unit</b> 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki (Japanese Pat. No. JP 3082537) "'537" and further in view of Masanori (Japanese Pat. No. JP5914226) "'226".**

**Consider claims 1, 6 and 17-18,** '537 teaches the use of an antistatic agent used as a coating, where the agent has a surface resistivity of  $10^{10}$  OMEGA or less with a surface roughness of 10-25 nanometers. (Constitution) While '537 does not specify the use of a conductive metal oxide, '537 does mention various surface active agent being used for the antistatic agent including inorganic compound particulates. '226 teaches an antistatic coating comprising tin oxide as its conductive material. (Constitution) It would have been obvious to a person of ordinary skill in the art to combine the antistatic coating of '537 with the antistatic coating of '226 to give heightened transmittance to the antistatic article.

**Consider claims 2, 3, 11, 12,** the claimed invention is taught by the combination of '537 and '226, with '226 stating that lowering the haze value as a positive achievement, therefore an article taught by the combination of '537 and '226 would be considered to have the properties of a haze value of 10% or lower and a total light

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transmittance of 84% or higher since '226 specifically states that these are the goals they are attempting to achieve in the abstract. These percentages are considered to be obvious to a person skilled in the art due to the purpose given by '226 in the abstract.

**Consider claim 4, 13**, the antistatic molded body is considered to be made in a variety of shapes since both '537 and '226 utilize polymers (which can be manipulated into a variety of shapes) as their substrate film, therefore it is considered obvious to a person skilled in the art to have these structures made in to a variety of three-dimensionally shaped with the antistatic coating thereon, including concave and convex parts.

**Consider claim 5, 14, 15, 16**, the claiming of spraying the antistatic coating material is considered to be a product by process limitation and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”, (*In re Thorpe*, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious different between the claimed product and the prior art product (*In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

**Claims 1, 4-6, 16, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki (Japanese Pat. No. JP 3082537) "'537" and further in view of Ito (U.S. Pub. No. 2003/0157317) "Ito".**

**Consider claims 1, 6 and 19-20,** '537 teaches the use of an antistatic agent used as a coating, where the agent has a surface resistivity of  $10^{10}$  OMEGA or less with a surface roughness of 10-25 nanometers. (Constitution) While '537 does not specify the use of a conductive metal oxide, '537 does mention various surface active agent being used for the antistatic agent including inorganic compound particulates. Ito teaches an antistatic layer that has a resistance of less than  $10^{12}$  OMEGA, preferably  $10^4$ --- $10^{12}$  OMEGA that uses tin oxide as the inorganic oxide. (Para. 35-37 and Para. 49) It would have been obvious to a person skilled in the art at the time of the invention of combine the antistatic agent of '537 with the coating of Ito to make a stronger, more adhesive coating to be placed over a film or substrate. (Para. 19)

**Consider claim 4,** Ito teaches that the substrate can be flat plats of molded articles in various shapes (Para. 33), therefore it is considered obvious to a person skilled in the art to have these structures made in to a variety of three-dimensionally shaped with the antistatic coating thereon, including concave and convex part.

**Consider claims 5 and 16,** Ito teaches that the antistatic layer can be applied by the use of a spraying method. (Para. 67) Additionally, the claiming of spraying the antistatic coating material is considered to be a product by process limitation and even

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though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”, (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (*In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki (Japanese Pat. No. JP 3082537) “’537”, Masanori (Japanese Pat. No. JP5914226) “’226” and further in view of Ito (U.S. Pub. No. 2003/0157317) “Ito”.**

**Consider claim 7,** ‘537 teaches the claimed article of claim 1 in combination with ‘226 or Ito. Ito teaches the use of a conductive metal oxide particles (tin oxide Para. 49) in conjunction with a binder resin (Para. 61) with an organic solvent of ethyl acetate (Para. 53) in addition to teaching the a solid matter concentration embodiment of 20% (Para. 188). ‘226 on the other hand teaches that the content of the tin oxide electroconductive fine powder is preferably between 45-80% by weight with a particle size of 20 nanometers. (Abstract) It would have been obvious for a person skilled in

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the art at the time of the invention of the invention to combine the article of '537 with the coating characteristics of '226 and Ito to obtain heightened transmittance with a lower haze value for the antistatic article. ('226, abstract)

**Claims 8-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Pub. No. 2003/0157317) "Ito" and further in view of Masanori (Japanese Pat. No. JP5914226) "'226".**

**Consider claims 8 and 9,** Ito teaches an antistatic coating material (Para. 35-36) with the use of a conductive metal oxide particles (tin oxide Para. 49) in conjunction with a binder resin (Para. 61) with an organic solvent of ethyl acetate (Para. 53) in addition to teaching the a solid matter concentration embodiment of 20% (Para. 188). '226 on the other hand teaches that the content of the tin oxide electroconductive fine powder is preferably between 45-80% by weight with a particle size of 20 nanometers, which is considered to encompass the limitation of 100nm and 200nm or smaller.

(Abstract) It would have been obvious for a person skilled in the art at the time of the invention of the invention to combine the article of Ito with the coating characteristics of '226 to obtain heightened transmittance with a lower haze value for the antistatic article. ('226, abstract)

**Consider claim 10,** since both Ito and '226 teach the article of claim 8, the article is considered to have the same characteristics as claimed in claim 10.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB



JENNIFER MCNEIL  
SUPERVISORY PATENT EXAMINER

1/22/04